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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,963	07/25/2000	Paul Turquand Keyser	YOR9-2000-0048	7040
7590	04/10/2007		EXAMINER	
William E. Lewis Ryan, Mason & Lewis LLP 90 Forest Avenue Locust Valley, NY 11560			STORK, KYLE R	
			ART UNIT	PAPER NUMBER
			2178	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/10/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/624,963	KEYSER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Kyle R. Stork	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 January 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4, 11, 19 and 23-35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4, 11, 19 and 23-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

1. This final office action is in response to the Request for Continued Examination (RCE) filed 11 January 2007.
2. Claims 1-4, 11, 19, and 23-25 are pending. Claims 5-10, 12-18, and 20-22 are cancelled.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, and 24-25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Michelman et al. (herein after Michelman), U.S. Patent No. 6,128,633 filed March 1997 issued October 2000 in view of Ruedisueli et al (herein after Ruedisueli), U.S. Patent No. 5,838,819 filed November 1995 issued November 1998.

In regard to independent claim 1, Michelman teaches of "A system for manipulating page-breaks in an electronic document. A User Interface Process provides a graphical user interface allowing a user to select a page-break within an electronic document and then identify a new location for the page-break. (Michelman Abstract Lines 1-5).

Michelman does not specifically teach of obtaining the data from a handwriting system. However, Ruedisueli teaches of a system includes a processor for processing the handwritten notes to generate the electronic copies, with each electronic copy associated with a respective identifier corresponding to at least one set of the respective handwritten notes, in which the identifiers facilitate the management of the electronic copies. The system includes an electronic notepad and can also include devices operatively connected to the electronic notepad for operating with the electronic notepad to receive, manage, merge, and/or display the electronic copies from the electronic notepad. (Ruedisueli Abstract Lines 2-12; compare with claim 1, "...obtaining electronic ink data from the handwriting system, the ink data being associated with the electronic document; and automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertions in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system."). It would have been obvious to one of ordinary skill at the time of the invention to apply Ruedisueli to Michelman, providing Michelman the benefit of adding an electronic notepad that include devices operatively connected to the electronic notepad for operating with the electronic notepad to receive, manage, merge, and/or display the electronic copies from the electronic notepad as taught by Ruedisueli Abstract Lines 8-12 to the automatic page break pagination which performs the steps of moving the selected page break to the new location and adjusting the remainder of the document to

accommodate the page-break at the new location as taught by Michelman Col 4 Lines 45-49.

In regard to dependent claim 2, Michelman does not specifically teach of a handwriting system being a personal digital notepad. However, Ruedisueli teaches that the system includes an electronic notepad and can also include devices operatively connected to the electronic notepad for operating with the electronic notepad to receive, manage, merge, and/or display the electronic copies from the electronic notepad. (Ruedisueli Abstract Lines 8-12; compare with claim 2, "...the handwriting system is a personal digital notepad."). It would have been obvious to one of ordinary skill at the time of the invention to apply Ruedisueli to Michelman, providing Michelman the benefit of having a system includes an electronic notepad and can also include devices operatively connected to the electronic notepad for operating with the electronic notepad to receive, manage, merge, and/or display the electronic copies from the electronic notepad as taught by Ruedisueli Abstract Lines 8-12.

In regard to dependent claim 3, Michelman teaches of "A System Process performs the steps of moving the selected page-break to the new location and adjusting the scaling and the automatic page-breaks for the remainder of the document to accommodate the page-break at the new location. (Michelman Abstract Lines 5-9; compare with claim 3, "...automatically inserting the one or more identified potential page breaks in the electronic document").

In regard to independent claim 4, Michelman teaches, "A User Interface Process provides a graphical user interface allowing a user to select a page-break within an

electronic document and then identify a new location for the page-break." (Michelman Abstract 2-5; compare with claim 4, "...presenting the one or more identified potential page breaks to a user for approval to automatically insert the one or more identified potential page breaks in the electronic document.")

In regard to independent claim 24, claim 24 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Michelman teaches that the "program modules may be physically located in different local and remote memory storage devices." (Michelman Column 6 Lines 32-34; compare with claim 24; "...a memory"). Michelman also teaches that "Moreover, those skilled in the art will appreciate that the invention may be practiced with other computer system configurations, including hand-held devices, multiprocessor systems, microprocessor-based or programmable consumer electronics, minicomputers, mainframe computers, and the like." (Michelman Column 7 Lines 48-53; compare with claim 24, "...at least one processor").

In regard to independent claim 25, claim 25 reflects similar subject matter as claimed in claim 1 and is rejected along the same rationale.

5. Claim 11, is rejected under 35 U.S.C. 103(a) as being unpatentable over Michelman et al. (herein after Michelman) in view of Ruedisueli et al. as applied to claim 1, and in further view of Forcier, U.S. Patent No. 6,502,114 B1 filed October 1998

issued December 2002 and in further view of Johari et al. (herein after Johari), U.S. Patent No. 5,911,146 filed May 1996 issued June 1999.

In regard to dependent claim 11, Michelman does not specifically teach of an insertion point. However, Johari teaches of "A modification or perturbation is a randomly selected change to one of the values defining the candidate solution. For example, a page break in the advertisement stream can be changed by randomly selecting one page break to delete and/or randomly selecting a page break to insert in the advertisement stream. (Johari Column 6 Lines 19-24; compare with claim 11, "...a confidence measure for the potential page break associated with the possible insertion point.") It would have been obvious to one of ordinary skill at the time of the invention to apply Johari to Michelman, providing Michelman the benefit of determining a confidence measure for a potential page break insertion that can be randomly selected.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michelman et al. in view of Ruedisueli et al. as applied in claim 1, and in further view of Mishra et al. (herein after Mishra), U.S. Patent No. 5,805,118 filed December 1995 issued September 1998.

In regard to dependent claim 19, Michelman does not specifically teach of a learning algorithm. However, Mishra teaches of a Display Protocol Specification and Learning Algorithm (Mishra Column 8 Line 4; compare with claim 19, "... identifying one or more potential page breaks further comprises the steps of utilizing a learning algorithm.") It would have been obvious to one of ordinary skill in the art at the time of

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the invention to apply Mishra to Michelman, providing Michelman the benefit of utilizing a learning algorithm.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michelman et al. in view of Ruedisueli et al. as applied to claims 1, 5 and 6, in further view of Forcier et al. as applied to claims 1,5, and 7, and in further view of Nakai et al. (herein after Nakai), U.S. Patent No. 5,909,221 filed December 1995 issued June 1999 and in further view of Johari et al. (herein after Johari), U.S. Patent No. 5,911,146 filed May 1996 issued June 1999.

In regard to dependent claim 23, Michelman does not explain the scoring procedure. However, Johari teaches of "A computer-based system for automatic pagination and layout of yellow pages or a commercial telephone directory uses a simulated annealing heuristic to refine a randomly determined candidate solution. The text and advertisements which are to be included in the yellow pages directory are ordered in two distinct data streams representing the order of text and the order of advertisements in the directory. The system determines a possible layout, called a candidate solution, by randomly setting parameters defining the pagination and layout. These parameters may include page breaks in the advertisement stream, column numbers for each advertisement, and an amount of padding or empty space to be added to each page. Once the parameters are set, the individual pages are laid out by putting the advertisements in the next available position in their assigned columns, and the text around the advertisements. The solution is scored based upon the guidelines

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for the format and layout of the yellow pages directory. The solution is then optimized using a simulated annealing heuristic, which utilizes small modifications or perturbations randomly made to the initial parameters of the candidate solution. The revised solution is scored and compared to the score of the prior solution. The revised solution is then kept according to a probabilistic formula relating the two scores. Through an iterative process of perturbations, scoring, and comparing, the candidate solution becomes optimized. The process is repeated multiple times for different initial candidate solutions, each of which is randomly determined. A best solution is then selected from all of the optimized candidate solutions." (Johari Abstract Lines 1-30; compare with claim 23, "...automatically identifying one or more potential page breaks further comprises the step of identifying a potential page break as a point offset from a possible insertion point determined in accordance with a scoring procedure." It would have been obvious to one of ordinary skill at the time of the invention to apply Johari to Michelman, providing Michelman the benefit of applying the scoring procedure to the page breaks.

### ***Response to Arguments***

8. Applicant's arguments filed 11 January 2007 have been fully considered but they are not persuasive.

The applicant's initial argument is that there is a clear lack of motivation to combine the Michelman and Ruedisueli references (page 6). The examiner respectfully disagrees. As the examiner has stated on previous occasions, it would have been

obvious to one of ordinary skill at the time of the invention to combine Ruedisueli and Michelman, since it would have allowed a user to add the electronic notepad having devices operatively connected to receive, manage, merge, and/or display copies having automatic page break pagination which performs the steps of moving the selected page break to the new location and adjusting the remainder of the document to accommodate the page-break at the new location (Michelman: column 4, lines 45-49). This proposed combination allows for automatic page breaks within an electronic notepad.

The applicant's second argument is that there is no reasonable expectation of success for the proposed Michelman and Ruedisueli combination (page 7). However, the examiner respectfully disagrees. Both Michelman and Ruedisueli are related to document processing. Ruedisueli discloses the use of an electronic document obtaining handwriting (abstract). Michelman is directed toward identifying page breaks within an electronic document. It would have allowed a user to add the electronic notepad having devices operatively connected to receive, manage, merge, and/or display copies having automatic page break pagination which performs the steps of moving the selected page break to the new location and adjusting the remainder of the document to accommodate the page-break at the new location (Michelman: column 4, lines 45-49). The examiner believes he has fulfilled the requirement for reasonable expectation of success. However, the applicant is invited to present evidence demonstrating that there was no reasonable expectation of success under MPEP 2143.02).

The applicant's third argument is that if combined, the combination of Michelman and Ruedisueli fails to disclose all the limitations of the claims (page 7). The examiner respectfully disagrees. The applicant argues that the proposed combination fails to disclose automatically identifying page breaks (pages 7-8). This is based upon the applicant's belief that Ruedisueli fails to disclose the automatic identification of page breaks (page 8). However, the examiner has already acknowledged that Ruedisueli fails to teach the limitation (see rejection above). However, Michelman discloses the limitation (abstract).

### ***Conclusion***

9. All claims are drawn to the same invention claimed earlier in the application and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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